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In re Application of :
KERN, Andrea et al :
U.S. Application No.: 08/637,752 :
PCT No.: PCT/EP94/03564 :
Int. Filing Date: 28 October 1994 :
Priority Date: 28 October 1993 :
Attorney Docket No.: 8484-013-999 :
For: ADENO-ASSOCIATED VIRUS - ITS :
DIAGNOSTIC USE WITH EARLY :
ABORTION :
:

DECISION ON
PETITION FOR REVIVAL
UNDER 37 CFR 1.137(b)

This decision is in response to applicants' "Petition to Revive Under 37 CFR § 1.137(b)," filed via facsimile on 01 August 1999.

BACKGROUND

On 28 October 1994, applicants filed international application PCT/EP94/03564 claiming priority to a German patent application filed 28 October 1993. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 04 May 1995.

On 24 April 1995, a Demand was filed with the International Preliminary Examination Authority electing the United States. The election was made prior to the expiration of 19 months from the priority date. Accordingly, the deadline for submission of a copy of the international application and payment of the basic national fee was extended to expire thirty months from the priority date, *i.e.*, 29 April 1996 (28 April 1996 was a Sunday).

On 02 May 1996, applicants filed a transmittal letter for entry into the national stage in the United States under 35 U.S.C. 371 which was accompanied by, *inter alia*, an unexecuted declaration; an unsigned statement claiming small entity status, a preliminary amendment; and authorization to charge the basic national fee and any additional fees to Deposit Account No. 16-1150.

On 04 March 1999, applicants submitted a Status Inquiry with regards to the above-captioned application.

On 14 April 1999, applicants were notified via a communication from the United States Patent and Trademark office that the above-captioned application was abandoned for failure to pay the basic national fee within thirty months from the earliest claimed priority date.

On 23 April 1999, applicants filed via facsimile the instant petition.

DISCUSSION

A petition under 37 CFR 1.137(b) requesting to revive an application on the grounds of unintentional delay must be accompanied by (1) a proper reply, (2) the petition fee required by law, (3) a statement that the "entire delay in filing the required reply from the due date for the reply to the filing of a grantable petition pursuant to this paragraph was unintentional," and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c).

Concerning item (1), paying the appropriate basic national fee is the proper reply. On 02 May 1996, applicants submitted an unsigned verified statement claiming small entity status with the transmittal letter. The verified statement claiming small entity status must be executed to be effective. Therefore, in accordance with 37 CFR 1.28(a)(1), the appropriate fees in this application are \$970.00 for the basic national fee (Fee Code 960), a \$130.00 surcharge for providing the declaration late (Fee Code 154), \$110.00 for five extra claims (Fee Code 966), \$164.00 for two extra independent claims (Fee Code 964), and \$270.00 for multiple dependent claims (Fee Code 969). Nevertheless, Counsel's Deposit Account No. 16-1150 has been charged the proper fees as authorized.

With regards to item (2), the petition fee of \$1,210.00 has been charged to Deposit Account No. 16-1150 as authorized.

Accordingly, items (1) and (2) above have been satisfied.

However, concerning item (3), the revised rule requires a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." See 62 Fed. Reg. at 53159; 1203 Off. Gaz. Pat. Office at 87. In the instant petition, applicants included a statement that "the failure to provide the full U.S. Basic National Fee was unintentional." Applicants' statement is insufficient. Moreover, applicants have not provided the requisite terminal disclaimer and fee required by item (4). A terminal disclaimer and fee are required in this application because it was filed before 08 June 1995. Since items (3) and (4) above has not been satisfied, the petition may not be properly granted at this time.

Furthermore, the declaration submitted on 02 May 1996 is not signed. Applicants need to provide a properly executed declaration after reviving this application.

CONCLUSION

The petition under 37 CFR 1.137(b) is **DISMISSED** without prejudice.

Since a grantable petition to revive has not been filed, the international application remains **ABANDONED** as to the United States.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)." A proper response must include the proper statement and a terminal disclaimer and fee. Applicants are advised that extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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